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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/787,042 | 02/25/2004 | Robert E. Harms | 9530.48110 | 4419 |

22235 7590 06/10/2005

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| EXAMINER |
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HWANG, VICTOR KENNY

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| ART UNIT | PAPER NUMBER |
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3764

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 10/787,042 | Applicant(s) HARMS ET AL. | |
| | Examiner Victor K. Hwang | Art Unit 3764 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

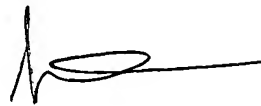
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


JEROME W. DONNELLY
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. Figures 2 and 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to under 37 CFR 1.84(h)(5) because Figures 3 and 4 show(s) modified forms of construction in the same view. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not

accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to because Figs. 1, 1a show extraneous text. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 and 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Landfair* (US Pat. 6,319,176 B1) in view of *Ho et al.* (US Pat. 6,258,918 B1). *Landfair* '176 discloses a weight assembly comprising a weight plate 10. A resilient coating 20 may cover the weight plate. The resilient coating 20 may be formed of urethane or like material (col. 6, lines 7-9). A portion of the resilient coating may include an indentation for the placement of a sticker or decal that bears a trademark (col. 3, lines 5-7). A trademark is considered by the examiner to read upon the claim limitations of advertising or a corporate logo. The resilient coating and/or sticker or decal is considered to read upon the claim limitation of a first coating and a sticker or decal would inherently comprise a coloring agent. The weight plate 10 has an aperture 14 through its center that is sized to fit barbell and dumbbell bars. A dumbbell is formed by securing a weight plate 10 on each end of a dumbbell handle.

Landfair '176 does not disclose an at least partially transparent second coating applied over the first coating (claims 1, 11, 16, 17, 18); wherein the second coating is substantially clear, whereby the first coating is at least partially visible through the second coating (claims 3, 13); the second coating comprises polyurethane (claims 4, 14); the first coating is one or more of the following: paint and powder coating (claim 7); the second coating is adapted for receiving a dumbbell handle (claims 9, 15); and the decal is comprised of vinyl material (claim 12).

Ho et al. discloses a clear polyurethane top coat and teaches that it is well known to use clear polyurethane as a top coat to cover and protect a base substrate and any indicia or decorative features located on the substrate. The articles may include various substrates upon

which printing or profiled graphics have been applied. The polyurethane material is generally clear or optically transparent (col. 1, lines 14-20).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the weight plate of *Landfair* '176 with an at least partially transparent second coating applied over the first coating, since *Ho et al.* teaches that it is well known to utilize a polyurethane top coat to cover and protect a base substrate and any indicia or decorative features located on the substrate (col. 1, lines 14-16) and that the polyurethane top coat is generally clear or optically transparent (col. 1, lines 19-20).

With regard to claim 7, *Ho et al.* is silent as to whether a first coating of polyurethane is paint or powder coat. The claimed phrase "wherein the first coating is one or more of the following: paint and powder coat" is being treated as a product by process limitation; that is, that the first coating of polyurethane is applied by paint and/or powder coat. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113. Thus, even though *Ho et al.* is silent as to the process used to apply the first coating of polyurethane, it appears that the product of *Ho et al.* would be the same or similar as that claimed.

With regard to claim 9, the weight plate of *Landfair* '176 is already adapted to receive a dumbbell handle, and therefore, the addition of a second coating would also necessarily be adapted for receiving the dumbbell handle.

With regard to claim 12, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the sticker or decal comprise vinyl material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Vinyl stickers and decals are well known in the art.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Landfair* (US Pat. 6,319,176 B1) as modified by *Ho et al.* (US Pat. 6,258,918 B1) as applied to claim 1 above, and further in view of *Handbook of Plastic Materials and Technology* (Chapter 41, Polyurethane Thermoplastic (TPU), Orchon, S., Consultant, Rubin, I., Editor, pgs. 501-504, 1990). *Landfair* '176 as modified by *Ho et al.* discloses the invention as claimed except for the second coating further comprising a UV protection chemical element.

The Polyurethane Thermoplastic chapter of the *Handbook* teaches that the dominant mechanism of TPU degradation is the autoxidation process, which is initiated by exposure to ultraviolet (UV) light (Section 41.5.1). Protection against UV effects can be enhanced by addition of UV stabilizers (Section 41.5.2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the polyurethane second coating of *Landfair* '176 as modified by *Ho et al.* with a UV protection chemical element, since the *Handbook of Plastic Materials and Technology* teaches that the addition of UV stabilizers enhances the protection of polyurethane against degradation due to UV effects.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hodnett, III (US Pat. 5,401,541), *Keller* (US Pat. 5,885,173), *Neves* (US Pat. 5,944,634), *Crast et al.* (US Pat. 6,165,564), *Dahl* (US Pat. 6,199,892 B1) and *Hua* (WO 03/066170 A1) disclose the use of a polyurethane clear coat applied over indicia to protect the underlying indicia layer. *Dahl* also teaches that decals may be vinyl decals.

Landfair (US Pat. 6,099,443), *Pearson et al.* (US Pat. 6,120,420) and *Vanderbleek* (US Pat. 6,132,344) disclose dumbbells comprising weight plates with at least one layer of resilient coating.

Vigiano (US Pat. Pub. 2004/0166997 A1) discloses a weight plate wherein the weight plate may have a powder coated layer.

Rust-Oleum Industrial Low VOC Urethane (Technical Data Sheet, 05/2003) discloses urethane as a paint product and the variety of colors available, including clear; and that the urethane is recommended to be applied over a first coating of primer.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor K. Hwang whose telephone number is (571) 272-4976. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM Eastern time.

The facsimile number for submitting papers directly to the examiner for informal correspondence is (571) 273-4976. The facsimile number for submitting all formal correspondence at this time is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on (571) 272-4887.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor K. Hwang
June 3, 2005

JEROME W. DONNELLY
PRIMARY EXAMINER

